

**REMARKS**

Claims 29-58 are pending. Applicant elects claims for examination, with traverse, and respectfully requests that the Office examine all of the pending claims.

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**Election/Restriction Requirement**

Claims 30-44 and 46-56 are subjected to a restriction requirement under 35 U.S.C. § 121 as containing two patentably distinct inventions, each of which are related as combination and subcombination. The Office groups the claims as follows:

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- I. Claims 30-44, drawn to sending an order to an electronic transaction system, classified in class 902, subclass 1.
- II. Claims 46-56, drawn to receiving and approving an order, classified in class 705, subclass 51.

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The Office also indicated that claims 29, 45, 57, and 58 link claim groups I and II, noting that the restriction requirement shall be withdrawn for a claim depending from, or otherwise requiring all of the limitations of, a linking claim deemed to be allowable.

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Applicant hereby elects, **with traverse**, to prosecute claims 46-56 in the event that the restriction requirement is maintained. The election is made with traverse because the restriction requirement is improper and should be withdrawn.

In summary, the restriction requirement is improper because the Office fails to explicitly state a reason and evidence for the restriction requirement being a serious burden. The Office, rather, lists five different possible categorical reasons without stating which of these possible reasons applies. Not only does the Office fail to state with specificity which possible reason applies, the Office fails to provide any evidence for any of these possible reasons. Further, Applicant provides evidence showing that no serious burden exists. Therefore, Applicant respectfully submits that the Office fails to establish a *prima facie* case for restriction under 35 U.S.C. § 121.

#### **No Explicit Reason or Evidence Given to Establish a “Serious Burden”**

The restriction requirement is improper because the Office offers **no explicit** reason or evidence in support of that reason to demonstrate a serious burden. MPEP 803 states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required. (Emphasis added).

The Office has not established with specificity a reason sufficient to show a serious burden. The only argument given by the Office is not specific, namely:

8. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

It is not sufficient, when establishing a *prima facie* case, to fail to provide explicit reasoning and evidence in support of that reasoning. Here the Office simply lists five possible reasons, stating “because one or more of the following reasons apply”. The Office must state, with specificity, which reason or reasons apply. On this basis alone the Office fails to establish a *prima facie* case showing a serious burden.

Further, the Office fails to provide any evidence for any of the listed possible reasons. Without explicit evidence an argument is simply a conclusion. Conclusions do not establish *prima facie* cases in any area, including showing a serious burden.

Therefore, the Office fails to establish a *prima facie* case of a serious burden on the Office.

### **Evidence Supports Contrary Position – That there is No “Serious Burden”**

While not provided as evidence, the Office has separately classified the claims of groups I and II. These classifications, however, can at best be provided as evidence of a burden but are not dispositive. Instead, it is potential evidence (not argued by the Office and so not establishing a *prima facie* case) to be weighed on its own and against other evidence. This evidence of a separate search classification must be correct and must outweigh other evidence. Applicant respectfully submits that either the classifications are incorrect, and thus cannot be used as evidence of a serious burden, or that sufficient evidence of there being no serious burden outweighs evidence of a burden implied by these classifications.

Applicant respectfully submits that the subject matter of many of the claims of group I are similar to those of group II, though they differ as to the independent claims on which each relies. These independent claims, however, are being searched and examined on the merits. As such, the subject matter of the different

independent claims is not relevant to an analysis of a serious search burden as to the claims of groups I and II, all of which are dependent claims on independent claims that will be examined together.

By way of example, Applicant supplies comparisons of the language of claims from group I with those of group II. The Office, by restricting claim 31 from 46, for example, is required to show a serious burden to examine claim 31 at the same time as claim 46. Note that the Office fully intends to examine claim 29, on which claim 31 relies, and claim 45, of which claim 46 relies.

Claim 31 recites:

The computer-implemented method as recited in claim 29, wherein the electronic transaction system includes a self-checkout register and the act of receiving the transaction request includes receiving the transaction request from the self-checkout register and through the wireless port.

Claim 46 recites:

The portable computing device as recited in claim 45, wherein the electronic transaction system includes a self-checkout register and the operation of receiving the transaction request includes receiving the transaction request from the self-checkout register and through the wireless port.

Applicant respectfully submits that the following differences, other than reliance on different independent claims that are both being examined, are insufficient to justify a serious burden on the office. The relevant difference between claims 31 and 46 is shown below:

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wherein the electronic transaction system includes a self-checkout register and [[the act]] the operation of receiving the transaction request includes receiving the transaction request from the self-checkout register and through the wireless port.

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Applicant respectfully submits that searching both “the act of receiving the transaction” and “the operation of receiving the transaction” does not constitute a serious burden on the Office.

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To further illustrate these similarities, which indicate that examining both groups of claims would be far from a serious burden, consider two more comparisons between claims of the two groups, excluding preamble language indicating their reliance on different independent claims.

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Relevant differences between claim 34 and claim 49:

wherein the [[act]] operation of receiving the selection includes receiving a unique biometric through the portable computing device.

Relevant differences between claim 36 and claim 51:

wherein the [[act]] operation of encrypting includes encrypting the transaction approval data using a private key of a public/private key pair, the private key uniquely held by the portable computing device.

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Applicant respectfully submits that searching both “the act of” and “the operation of” does not constitute a serious burden on the Office. Furthermore, searching both “the portable computing device” and “the portable device” does not constitute a serious burden on the Office.

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For the sake of brevity, Applicant forgoes providing other examples, though many others are readily apparent on comparing claims of groups I and II.

Applicant respectfully submits, based on this evidence and the Office’s failure to establish a *prima facie* case for restricting these claims, that all of pending claims 29-58 must be examined together.

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**Conclusion**

All of the claims are believed to be in condition for allowance. Accordingly, Applicant requests issuance of a Notice of Allowability. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

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